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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/852,049

05/09/2001

Thomas R. Firman

10591-003009

4504

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7590

08/05/2004

FISH & RICHARDSON PC
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BOSTON, MA 02110

EXAMINER

KNEPPER, DAVID D

ART UNIT

PAPER NUMBER

2654

DATE MAILED: 08/05/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/852,049

Applicant(s)

FIRMAN, THOMAS R.

Examiner

David D. Knepper

Art Unit

2654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8</u> . | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's correspondence filed on 15 October 2002 (IDS, paper #8) has been received and considered.
2. The Examiner called Mr. David Feigenbaum on 8 July 2004 to resolve claim issues that resulted because an amendment entered on 11 April 2002 had an erroneous serial number from parent case 08/976,908. This amendment canceled claims 1-4 and entered new claims numbered 5-13.

A second amendment entered 15 October 2002 had the proper serial number (for the instant application) on it and entered new claims 14-25. Some of these claims seemed to be the same as some of the earlier filed claims.

To simplify the resolution of any errors or minor discrepancies noted above, Mr. Feigenbaum authorized Examiner Knepper to cancel claims 5-13.

Examiner's Amendment

3. Cancel claims 5-13.
Claims 14-25 are pending. Claims 1-13 have been deleted.

Restriction

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 14, drawn to tables used by computer programs to identify application menu entries that contain control button controls and the corresponding control commands, classified in class 719, subclass 330 (Remote procedure call) or class 717, subclass 143, 162 (Software development, linking).

- II. Claims 15-25, drawn to speech recognition that converts utterances into computer control signals, classified in class 704, subclass 275 (Speech controlled systems).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. The Examiner called on 13 July 2004 with the above restriction requirement. During a telephone conversation with Mr. Feigenbaum on 14 July 2004 a provisional election was made without traverse to prosecute the invention of Group II, claims 15-25. Affirmation of this election must be made by applicant in replying to this Office action. Claim 14 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The applicant is referred also to a similar restriction requirement in parent application 08/450,776 (paper #7, mailed 2 January 1996).

6. The restriction requirement is made FINAL.

7. This application contains claim 14 drawn to an invention nonelected without traverse in the reply noted above. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Drawings

8. The drawings are objected to because it is unclear whether all of the figures are necessary to support the claimed invention. It is possible that the lengthy specification could be shortened if elements are unnecessary or could be considered as prior art. Any changes thereto could cause some figures to be deleted as appropriate.

Correction is required.

Priority Claims

9. The applicant(s) should check their filing receipts and/or the Patent Application Information Retrieval (PAIR) system for the acknowledgment of their **domestic** priority or benefit claims (if any) under 35 USC 119(e), 120 or 121 (37 CFR 1.78).

The application is identified as a continuation in the cover letter of 9 May 2001. While the corrected filing receipt appears to have the proper continuing information, this information has not been entered in the beginning of the specification as required by 35 USC 120. The specification papers have been reviewed and an amendment entering this material could not be found. However, the fact that the applicant requested a corrected filing receipt on 29 November 2001 with the continuing data indicates that the inclusion of this data was intended and it is possible that a paper with such an amendment or an Application Data Sheet may have been misplaced since OIPE did originally enter most of the continuing data requested on the original filing receipt.

Specification

10. The disclosure is objected to because of the following informalities:

This application contains a computer program listing (marked APPENDIX C) of more than three hundred (300) lines. In accordance with 37 CFR 1.96(c), a computer program listing contained on more than three hundred (300) lines, must be submitted as a computer program listing appendix on compact disc conforming to the standards set forth in 37 CFR 1.96(c)(2) and

must be appropriately referenced in the specification (see 37 CFR 1.77(b)(4)). Accordingly, applicant is required to cancel the current computer program listing, file a computer program listing appendix on compact disc in compliance with 37 CFR 1.96(c), and insert an appropriate reference to the newly added computer program listing appendix on compact disc at the beginning of the specification.

The 657 pages that follow page 48 appear to be copied from a document titled "Voice NavigatorTM Developer's Reference Manual". It appears that some references to figures were added to these pages but the pages themselves do not conform to the standards required for a US patent application.

Content of Specification (-select portions-)

- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification

should refer to another patent or readily available publication which adequately describes the subject matter.

The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claims

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 15-25 are rejected under 35 U.S.C. § 103 as being unpatentable over Goldhor (5,231,670) in view of McKiel (5,133,011).

As per claims 15, 18, 22 and 23 Goldhor teaches "a voice user interface" (see abstract):

“recognizing a voiced utterance and for providing corresponding signals as input to said computer” (his recognition of simple spoken words as well as spoken commands, abstract, lines 11-17 and figure 1, item 18);

“converting said voiced utterance into a command string including a command simulating a mouse function” (suggested by his abstract noted above; his translation may also be any other legal input into a particular application, col. 4, lines 10-11; and other input events include typed input, input from pointing devices such as a mouse, etc, col. 6, lines 46-48 which suggests that it is well known to recognize speech as commands that mimic keyboard and mouse inputs, which inherently includes moving a pointer on a graphical user interface).

It is noted that Goldhor does not explicitly teach “simulating a mouse function”. However, he teaches that it is well know to combine speech recognition with common keyboard and mouse inputs as noted above. McKiel teaches details for linear vocal control of cursor position within a computer display with his Graphic User Interface (col. 1 and Figure 1). It would have been obvious for a person having ordinary skill in the pertinent art, at the time the invention was made, to manipulate the movement of the cursor using vocal commands as taught by McKiel in the system of Goldhor, because this would enable a person who is not physically able to move the mouse to be able to move the cursor via vocal commands.

As per claim 16, the use of a “command” is discussed in claim 15.

Claim 17: See claim 15 above. Converting based on a “state of said program” is taught by Goldhor in col. 1, lines 55-60 and col. 8, lines 24-27 where he discusses controlling the recognizer state and application state.

Claim 19: A number of text “arguments” are shown for generating commands that require more than one word in figures 5-9 and 11.

Claims 20, 21: See claim 15 above. Substituting voice inputs for text inherently affects the operating system that relies upon inputs to determine what the user is doing and how to react. The teachings of McKiel, for example, for controlling the cursor position would be capable of selecting anything that may be displayed on a graphical user interface (column 1). The teachings of Goldhor teach that it is well known to use speech to substitute or mimic text (keyboard) input thus rendering it obvious to use either or both (see col. 2, lines 40-61) as input events (col. 6, lines 26-37 and 44-49).

Claims 24, 25: See claim 15 above. A set of representations that allow “mapping from a member of said set of internal representations to a member of said set of output strings” is taught by Goldhor, for one-to-one mapping used by said converter (col. 5, lines 3-5 and lines 61-66). Permitting multiple recognizer representations to be mapped to a single command (multiple-to-one) is taught in col. 1, lines 27-34 and col. 6, lines 18-26.

13. This is a continuation of applicant's earlier Application No. 08976,908. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any response to this action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

TC2600 Fax Center
(703) 872-9315

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644.

The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-9645.

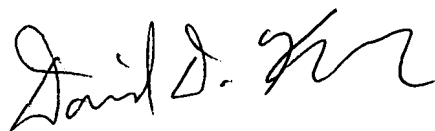
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Paper #9

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "David D. Knepper", with a stylized flourish at the end.

David D. Knepper
Primary Examiner
Art Unit 2654
July 19, 2004